

ATTORNEY DOCKET NO. 13529STUS01U (NORT10-00322)
U.S. SERIAL No. 09/735,499
PATENT

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Reconsideration of the Claims is respectfully requested.

I. **REJECTION UNDER 35 U.S.C. § 102**

Claims 1, 2, 4, 5, 7, 8 and 12-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Helfman, et al. (US 6,393,513 B1). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

With respect to independent Claims 1, 14, 18 and 19, the Office Action argues that "Helfman discloses a means for determining from the stored message status information which messages in the messaging system are new and for which notification has not been cleared (column 1, lines 11-17)." Office Action, pp. 2, 4 and 5. For ease of reference, Applicant provides the following relevant portion of Helfman (Col. 1, lines 11-23) reciting:

When a user logs onto the server, to use one of the application programs, the e-mail system may examine the queue of e-mail messages held in the user's

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mailbox. If messages are found stored in the mailbox, the system may notify the user, as by a notice stating, "You have mail." Alternatively, if new messages are found, which the user has not accessed previously, the notice may instead read, "You have NEW mail."

When the user calls for the mail, the system presents a list of the messages stored in the mailbox on the user's display screen, together with selected information about each, such as the identity of the sender, the date and time of dispatch, and so on. Col 1, lines 11-23.

The first paragraph of the cited passage of Helfman discloses that when email messages are found stored in the mailbox, the system may notify the user by stating either "You have mail" or alternatively, "You have NEW mail" (when new messages are found which the user has not accessed previously). Thus, this portion of Helfman fails to refer to a "list of notifications", as recited in the Applicant's claims.

The second paragraph of the above-identified text of Helfman recites that when the user calls for the mail, a list of messages stored in the mailbox is displayed (along with certain selected information). No description of which messages are displayed, thus the displayed list appears to refer to a list of all stored messages in the inbox. The cited portion of Helfman clearly does not disclose a list of message notifications associated with only those messages determined to be new and for which a notification has not been cleared. Helfman simply does not disclose this element/feature of Applicant's claims.

With respect to independent Claims 1, 14, 15, 17, 18 and 19, the Office Action further argues with that "Helfman discloses a user interface for providing to a user a list of message notifications associated only with those messages determined to be new message from which a notification has not been cleared (column 5, lines 32-37), wherein Helfman refers to unread

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and new messages and in addition to total messages present, wherein these total messages are nonetheless associated with these new messages." Office Action, page 2. For ease of reference, Applicant sets forth below the cited text of Helfman (Col. 5, lines 32-37):

Window 40 contains (1) a column 47 indicating the names of the mailboxes; (2) a column 49 indicating both the number of unread messages, and the total number of messages, within each mailbox; (3) a column 52 indicating the time/date stamp of the oldest unread message; (4) two columns labeled 55.

Helfman's display shows the names of multiple mailboxes, a column indicating the total number of messages and number of unread messages in each such mailbox, and date/stamp information of the oldest unread message. Clearly, no "list of message notifications" for messages in a mailbox is described in the cited passage -- there is described only names of mailboxes, number of total messages and number of unread messages in each mailbox, and date/stamp information about the single oldest message in each respective mailbox.

As presently understood, the main teaching of Helfman is the automatic sorting of incoming mail into separate mailboxes. Helfman, Abstract. The sorting is typically based upon a data field within the email message itself, such as the originating source. Col. 3, lines 1-45. The multiple mailboxes may be prioritized and ranked, and alarms set for certain conditions. Col. 3, line 56 through Col. 5, line 57.

Though Helfman does present to the user a list of the messages stored in a particular mailbox, the list of stored messages appears to be a list of all messages stored in that mailbox. Helfman fails to identify or disclose a list of message notifications associated with only those messages determined to be new and for which a notification has not been cleared. As described

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above, Helfman is directed to automatically sorting incoming messages into separate mailboxes, and there is no disclosure, teaching or suggestion to display a list of only those messages in the mailbox that are new and for which a notification has not been cleared. Thus, in distinct contrast, the Applicant's invention, as described in the specification, provides an enhancement to messaging systems by allowing a user to manage only new messages for which a notification has not been cleared without having to access or download the entire set of messages. Specification, Abstract.

In addition, Helfman fails to disclose means permitting a user to select a particular notification from said list for manipulation. (Claims 1, 14, 15, 17, 18 and 19). The cited portion of Helfman recites that "when a user selects a message from the list, the system erases the list from the screen, and displays the selected message instead." Col. 1, lines 23-25. There is no description of selecting a particular notification and manipulating that notification.

Helfman does not disclose means for determining (from stored message status information) which messages are both new and for which a notification has not been cleared, and a user interface for providing (or presenting) a list of message notifications associated with only those messages that were determined to be both new and for which a notification has not been cleared.

For all the foregoing reasons, Applicant respectfully submits that Helfman fails to identically disclose each and every element/feature of Applicant's claimed invention, arranged as they are in independent Claims 1, 14, 15, 17, 18 and 19 (and their dependent Claims).

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Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1, 2, 4, 5, 7, 8 and 12-20.

II. REJECTION UNDER 35 U.S.C. § 103

Claims 3, 6 and 9-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Helfman, et al. (US 6,393,513 B1) in view of Sylvan, et al. (US 5,943,055). The rejection is respectfully traversed.

Claims 3, 6 and 9-11 depend directly or indirectly from independent Claim 1. As described above, Helfman fails to describe all the elements/features recited in independent Claim 1. Moreover, as set forth in one of Applicant's prior response, Sylvan similarly fails to describe these elements/features. Therefore, Applicant respectfully submits that none of the references, either alone or in combination, disclose, teach or suggest the Applicant's invention as recited in Claims 3, 6 and 9-11.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 3, 6 and 9-11.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

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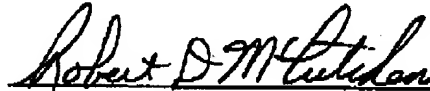
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 7/18/2005



Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: rmccutcheon@davismunck.com

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